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| 09/837,094 | 04/18/2001 | James M. Sheppard JR. | 3129 | 8428 |

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| EXAMINER | |
|---|---|
| BEFUMO, JENNA LEIGH | |
| **ART UNIT** | **PAPER NUMBER** |
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DATE MAILED: 10/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/837,094 | Applicant(s) SHEPPARD, JAMES M. |
|---|---|---|
| | Examiner Jenna-Leigh Befumo | Art Unit 1771 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) 1-20 is/are pending in the application.

4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-15 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 18 April 2001 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
4)☐ Interview Summary (PTO-413) Paper No(s). _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1 - 15, drawn to a woven textile with a graphic impression, classified in class 428, subclass 542.6.

   II. Claims 16 - 20, drawn to a method of printing, classified in class 427, subclass 256$^{+}$.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the woven textile can be made on other weaving looms such as a cam or jacquard loom, instead of a dobby loom.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Gregory Clements on September 20, 2002 a provisional election was made with traverse to prosecute the invention of group I, claims 1 - 15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16 - 20 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference signs mentioned in the description: 18 mentioned on page 9 of the specification. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

6. Claims 6, 8, 10, 11, 14, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 6 recites the limitation "the class" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claims 8, 10, 14, and 15 are similarly rejected.

8. Claim 10 recites the limitation "said area" in line 1. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 11 recites the limitation "said impression" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1 – 15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 15 of copending Application No. 09/747,529. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the jacquard woven textile recited in claim 1 of 09/747,529 can be a more intricate design due to the jacquard loom, both the dobby loom and jacquard loom can also produce simple woven fabrics. Thus, the claims of 09/747,529 would encompass the printed fabric recited in the claims of this application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 1 – 15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 – 15 of copending Application No. 09/837,093. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the dobby woven textile recited in claim 1 of this application can be a more intricate design due to the dobby loom, the woven textile can also be a simple woven fabrics that can be made by a cam loom, recited in 09/837,093. Thus, the claims of this application would encompass the printed fabric recited in the claims of 09/837,093.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

14. Claims 1 – 4, 7, 9, and 13 – 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hobson (4,259,994).

Hobson discloses a method for producing patterned fabrics comprising printing a design onto pile warp yarns, winding the warp yarn onto a warp beam and weaving a terry fabric (abstract). A woven fabric will inherently have a hem end and a selvage end since woven fabrics are produced with definite widths and lengths based on the final product. Hobson discloses that the fabric is produced on a tappet or dobby loom (column 2, lines 19 – 20). Hobson discloses that the fabric can be a terry cloth towel (column 1, line 6), and the pile loops can be cut or cropped to form sheared pile (column 2, lines 33 – 38). The pattern may be applied to the face side while the reverse side of the fabric is ecru or bleached (column 2, lines 47 – 50). Also, the fabric may have one design on the face (floral) and another design on the reverse side (i.e., striped, colored, or plain) (column 2, lines 62 – 64). Further, Hobson discloses creating a design with a floral border on the edges and central area between the border areas which can be blue or

gold (column 3, lines 8 – 10 and 33 – 35). Finally, Hobson teaches the fabric can include additional designs adding a dobby pattern such as a geometric figure or sculptured effects to the woven fabric (column 3, lines 48 – 50). Thus, claims 1, 2, 3, 4, 7, 9, 14 and 15 are anticipated.

Since the patentability of a product does not depend on its method of production, the method limitations recited in claim 13 are not given patentable weight at this time. Thus, Hobson anticipates claims 13, since Hobson discloses a woven fabric with a graphic image printed on the fabric.

15. Claims 1, 2, 14, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Carpenter et al. (5,983,952).

Carpenter et al. discloses that it is known to apply printed patterns to woven fabrics to obtain a printed design in combination with a woven design (column 1, lines 36 – 42). The weaving device can be a cam, dobby, or jacquard weaving device (column 3, lines 1 – 3). Carpenter et al. discloses printing a pattern onto the warp yarns as well as using different colored yarns or different weave patterns to produce graphic images in the fabric (column 4, lines 24 – 38). Carpenter et al. teaches that the ground weave can have a different color than the images, or motifs, on the fabric (column 5, lines 55 – 57). The printed design can be applied using a rotary screen printer, heat transfer device, of jet printer (column 6, lines 23 – 25). The fabric would inherently have a hem and selvage end. Thus, claims 1 and 2 are anticipated.

Claims 14 and 15 are rejected with claim 1, since the intended use of the woven fabric fails to add any further physical structural limitations to the woven fabric of claim 1 and is not given any patentable weight at this time.

***Claim Rejections - 35 USC § 103***

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17. Claims 5, 6, 8, and 10 – 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hobson.

The features of Hobson have been set forth above. Hobson fails to teach using the design pattern or figures recited by the Applicant. However, while the graphic impression is given patentable weight since it materially affects the structure of the final product, the specific design of the impression does not.

Further, it would have been obvious for one having ordinary skill in the art to modify the design pattern to include different shapes, colors, or images, so that the product would be more visually and aesthetically pleasing to a broader consumer audience or to replicate more expensive fabrics or designs. Thus, claims 5, 6, 8, and 10 – 12 are rejected.

18. Claims 3 – 8 and 10 – 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carpenter et al.

The features of Carpenter et al. have been set forth above. Carpenter et al. fails to teach the patterns for the printed fabric. As set forth above, since the design pattern only affects the aesthetic appearance of the fabric and not the structural characteristics of the overall product, the specific design elements are not given patentable weight. In other words, the pattern of the graphic image does not patentably distinguish one printed fabric from another printed fabric.

Further, Carpenter et al. fails to limit the design to a specific shape or pattern. Thus, it would have been obvious for one having ordinary skill in the art to modify the design pattern by using various shapes and design patterns as the graphic impression on the fabric, to make the end product more visually and aesthetically appealing to consumers to reach a broader consumer market or to replicate more expensive fabrics or designs. Thus, claims 3 – 8 and 10 – 13 are rejected.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (703) 605-1170. The examiner can normally be reached on Monday - Friday (9:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jenna-Leigh Befumo
September 27, 2002

TERREL MORRIS
SUPERVISORY PATENT EXAMINER
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